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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,417	04/13/2007	Hiroshi Yahata	50478-3200	2430
53044 7590 05/27/2010 SNELL & WILMER L.L.P. (Panasonic) 600 ANTON BOULEVARD SUITE 1400 COSTA MESA, CA 92626				
EXAMINER SHIBRU, HELEN				
ART UNIT 2621		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/586,417

**Applicant(s)**

YAHATA, HIROSHI

**Examiner**

HELEN SHIBRU

**Art Unit**

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 February 2010.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-15 is/are pending in the application.  
4a) Of the above claim(s) 7 and 10-13 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 6, 8-9, 14-15 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/GS-08)  
Paper No(s)/Mail Date 02/03/2010  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. The amendments, filed 12/13/2007, have been entered and made of record. Claims 6-15 are pending, claims 7 and 10-13 are withdrawn from further consideration, and claims 1-5 are cancelled. In view of Applicant's amendment, the rejection of claim 6 under 35 U.S.C. 112 is hereby withdrawn.

***Response to Arguments***

2. Applicant's arguments with respect to claims 6, 8-9, and 14-15 have been considered but are moot in view of the new ground(s) of rejection. See also the reason sets forth below in regard to the rejection under **35 USC § 101**.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6, 8-9, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itoi (US PG PUB 2001/0012440) in view of Strietzel (US Pat. No. 6, 950, 804).

Regarding claim 6, Itoi teaches a playback device for executing playback of video composed of a plurality of frame images, comprising:

a read unit operable to read a video stream from a recording medium (see paragraph 0044);

a frame memory (see TV 5 in figure 1);

a video decoder operable to decode the video stream so as to sequentially obtain and write the frame images on the frame memory (see paragraphs 0044-0045);

an output unit operable to generate a video signal from the frame images sequentially written on the frame memory and output the video signal (see paragraph 0048);

an output control unit operable to cause the output unit to output the video signal with the addition of the supplemental information (see paragraphs 0019, 0041 and 0043 contents with commercial outputted); and

an assigning unit operable to assign copy control information to the video signal output with the addition of the supplemental information, the copy control information defining a less strict restriction than another copy control information to be assigned to the video signal output without the addition of the supplemental information (see paragraph 0062 and claim 7 where the prior art teaches contents with out commercial message are controlled and contents with commercial having control code representing copy-free condition, see also paragraph 0019, the control means control the recording apparatus to record contents, copy once content not include commercial (referring to video signal without the addition of the supplemental information and more restrict (by assigning or permitting copying only once); content without commercial being copy free (referring to video signal with additional information, and less restrict), i.e. unlimited copying vs. copying once where the unlimited copying being less restrict than copying once; therefore Itoi has the capability of assigning copy control information to the video signal).

Claim 1 differs from Itoi in that the claim further requires a setup unit to accept a user operation to allow addition of supplemental information to the video signal and outputting video

signal with the addition of the supplemental information when the user operation allows the addition.

In the same field of endeavor Strietzel discloses option provided to the user for limited or unlimited access to the content (see abstract). The prior art teaches the user provided with the option to purchase the content item, and once purchased, the user would have free access to that content item thereafter (see col. 4 lines 24-33). Strietzel discloses the cost of the service being subsidized by short, highly targeted advertisements that are in the same format as and strategically appended to each content (referring to addition of supplemental information to the video signal) (see col. 4 lines 3-7). See figures 2 and 3, if the user selects to purchase the item, the item downloaded (copied) to the user without advertisement, however if the user selects advertising as a payment option, the advertisement appended to the content (see also claim 1 of the prior art and col. 9 lines 51-66). The prior art teaches based on status indicator, advertisements are added to the user (see col. 7 line 66-col. 8 line 11). Strietzel further teaches after a particular user has downloaded a particular content item and received an associated advertisement a predetermined number of times, the user can thereafter access the content item without having advertisement attached. Essentially the user has the ability to earn free access to content by receiving the advertisement (see col. 10 lines 48-67, referring to video signal with less strict restriction with addition of supplemental information). The prior art also teaches storing custom index in custom area (see col. 8 lines 28-34).

Therefore in light of the teaching in Strietzel it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Itoi by including a user

operation to allow addition of supplemental information in order to provide the user a flexibility in determining how to pay for content.

Regarding claim 8, Itio teaches the recording medium is a portable recording medium (see figure 1 and paragraphs 0034-0037), the playback device further comprises: a built-in recording medium storing a supplemental information stream (see paragraph 0034 and 0061 and figure 2), the read unit is further operable to read the supplemental information stream from the built-in recording medium (see claims 1-2), the playback device further comprises: a supplemental information decoder operable to decode the supplemental information stream (see claim 7), and the supplemental information is an image obtained by decoding the supplemental information stream (see paragraph 0056).

Regarding claim 9, Itio discloses the built-in recording medium stores multi-path information binding the supplemental information stream to a section of the video stream on the portable medium (see paragraph 0067), and the output control unit causes the video signal to be output with the addition of the supplemental information when a current playback point reaches the section (see paragraphs 0068-0069). See also claim 6 rejection above.

Regarding claims 14-15, the limitation of claims 14-15 can be found in claim 6 above. Therefore claims 14-15 are analyzed and rejected for the same reason.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claim 14 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In the state of the art, transitory signals are commonplace as a medium for transmitting computer instruction and thus, in the absence of any evidence to the contrary and give the broadest reasonable interpretation, the scope of a "computer readable medium" covers a signal per se."

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tozaki (US Pat. No. 5, 729, 516) discloses assigning copy control information to each VTS; hence assigning copy control information to selected video signal is well known.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571)272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/HELEN SHIBRU/  
Examiner, Art Unit 2621  
May 21, 2010

/Thai Tran/  
Supervisory Patent Examiner, Art Unit 2621